Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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<u>Ex parte</u> VIKTORS BERSTIS

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Appeal No. 2002-0614
Application No. 08/976,888[1]

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ON BRIEF

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Before BARRETT, FLEMING and SAADAT, <u>Administrative Patent Judges</u>.
SAADAT, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-28, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellant's invention is directed to the use of uniform resource locators to access a file system in a communication

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[1] Application for patent filed November 21, 1997.

network wherein different interfaces to access applications via

the Internet or a local network are not required. First, a

command is received to access a first file wherein a device

evaluates the command to determine a first file type of the first

file. The first file is then retrieved from a remote data

processing system when the first file type indicates that the

first file is stored outside the local data processing system

(specification, page 8).

Representative independent claim 1 is reproduced as follows:

1.   A computer program product in a computer readable
medium comprising:

an operating system on a local data processing system,
said operating system comprising:

input means for receiving a command to access a
first file;

means for evaluating the command to determine a
first type of the first file; and

means for retrieving the first file from a remote
data processing system when the first file type
indicates the first file is stored outside the local
data processing system.

The Examiner relies on the following references in rejecting

the claims:

Walls et al. (Walls)	5,848,410	Dec. 8, 1998
		(filed Oct. 8, 1997)
Freund	5,987,611	Nov. 16, 1999
		(filed May 6, 1997)

Claims 1-5, 7-15, 17-24 and 26-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Walls.

Claims 6,16 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walls in view of Freund.

We make reference to the answer (Paper No. 23, mailed August 27, 2001)[2] for the Examiner's reasoning, and to the brief (Paper No. 22, filed July 18, 2001) for Appellant's arguments thereagainst.

OPINION

In rejecting claims 1-5, 7-15, 17-24 and 26-28 under 35 U.S.C. § 102, the Examiner refers to table 1 of Walls and equates file-system definer 222 (col. 11, line 62 through col. 12, line 5) to the claimed means for evaluating the command to determine a first type of the first file (non-final Office action, page 3). The Examiner further characterizes the field name "Remote Location" listed in Table 1 of Walls (col. 17, lines 40-49) as the claimed means for retrieving the first file from a remote data processing system when the first file type indicates its storage outside the local data processing system (id.).

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[2] Although the Examiner does not refer to any particular one of the previous Office actions for the complete text of the claim rejections, we find that a non-final Office action (Paper No. 13, mailed September 9, 2000) contains the complete statement of the rejection, to which we refer.

Appellant argues that the teachings of Walls relate to a
storage data structure built by an index builder which provide
for a system and method for indexing information stored in one or
more sources of information such as a database (brief, page 5).
Appellant points out that Walls merely discloses a continuous
indexer (col. 3, lines 50-55) that is configured to search one or
more files in order to provide the user with a continuously
updated index of information contained within the file system
(id.).

In response to Appellant's arguments, the Examiner asserts
that "Walls teaches the same functionality of generating a file
system from the remote data processing and then storing the
retrieved file in the local memory" (answer, page 3). The
Examiner further relies on one of the field names listed in table
1 of Walls (col. 17, lines 40-49) and asserts that examining the
"Remote Location" field of the file that contains a binary
indicator determines if the first type of the file is a local or
remote while the feature of evaluating the command is inherent in
the system (answer, page 4).

A rejection for anticipation under section 102 requires that
each and every limitation of the claimed invention be disclosed
in a single prior art reference. In re Paulsen, 30 F.3d 1475,
1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). See also Atlas

Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943,

1947 (Fed. Cir. 1999).

We observe that Walls relates to a system and method for

comprehensively and continuously indexing information stored in

one or more sources of information such as a data base (col. 3,

lines 48-50) by using descriptive indexing elements such as

titles of files or keywords (col. 4, lines 37-40). The portion

of table 1 relied on by the Examiner (col. 17, lines 40-49)

actually describes the location of a file that is to be indexed.

However, Walls neither discloses nor suggests using any means for

evaluating the received command to determine a first type of a

the first file which may indicate that the first file to be

retrieved is stored outside the local data processing. In that

regard, Walls merely refers to generator 234 which inserts

pointers in storage data structure so that records in storage

data structure are associated with each other by their primary

keywords (col. 19, lines 24-28) and, in fact, shows that the

location where the file is stored is already known and the access

command need not be evaluated.

We disagree with the Examiner that the feature of evaluating

the received command to determine the first type of the first

file is inherent in the system since Walls provides for a "Remote

Location" field for indexing data (answer, page 4). Although

Walls provides for an indicator to be set to indicate remote file
location, a pointer to that file is already inserted by generator
234 (col. 19, lines 52-56) which means that the file location is
known prior to retrieving the file. Furthermore, "[to establish
inherency, the extrinsic evidence 'must make clear that the
missing descriptive matter is necessarily present in the thing
described in the reference, and that it would be so recognized by
person of ordinary skill.'" In re Robinson, 169 F.3d 743, * 49
USPQ2d 1949, 1950-1951 (Fed. Cir. 1999) citing Continental Can
Co. V. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749
(Fed. Cir. 1991). "Inherency, however, may not be established by
probabilities or possibilities. The mere fact that a certain
thing may result for a given set of circumstances is not
sufficient." Id. 948 F.2d at 1269, 20 USPQ2d at 1749. Here the
examiner has not pointed to, nor do we find, any teaching in the
prior art that would disclose or fairly suggest that existence of
the "Remote Location" field necessarily indicates the presence of
the claimed "means for evaluating the command to determine a
first type file of the first file" after a command to access a
first file is received. In fact, since Walls provides for
pointers to the files that are already accessed, there is no need
for determining the location of he file. Accordingly, we find
that the Examiner has failed to meet the burden of providing a

prima facie case of anticipation and the 35 U.S.C. § 102 rejection of claims 1-5, 7-15, 17-24 and 26-28 over Walls cannot be sustained.

Turning now to the 35 U.S.C. § 103 rejection of claims 6, 16 and 25, we note that the Examiner further relies on Freund for teaching a socket for communicating between the local and the remote data processing systems (non-final Office action, page 5). Freund relates to a system and method for regulating access and maintaining security of individual computer systems and local area networks connected to larger open networks (col. 1, lines 25-30). However, since there is no disclosure in Freund that relates to a "means for evaluating the command to determine a first type file of the first file" after a command to access a first file is received, the deficiencies of Walls as discussed above with respect to claims 1-5, 7-15, 17-24 and 26-28 cannot be overcome. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 6, 16 and 25 over Walls and Freund.

CONCLUSION

In view of the foregoing, the decision of the Examiner to reject claims 1-5, 7-15, 17-24 and 26-28 under 35 U.S.C. § 102 and claims 6, 16 and 25 under 35 U.S.C. § 103 is reversed.

REVERSED

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LEE E. BARRETT	)
Administrative Patent Judge	)
	)
	)
	) BOARD OF PATENT
MICHAEL R. FLEMING	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
MAHSHID D. SAADAT	)
Administrative Patent Judge	)

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